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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/054,180	04/01/1998	BRIAN J. REISTAD	06543035001	2217
24573	7590	06/14/2006	EXAMINER	
BELL, BOYD & LLOYD, LLC			BACKER, FIRMIN	
PO BOX 1135			ART UNIT	
CHICAGO, IL 60690-1135			PAPER NUMBER	
			3621	

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/054,180	REISTAD ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	FIRMN BACKER	3621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 March 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-36 and 39-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-36 and 39-63 is/are rejected.
- 7) ☐ Claim(s) 19-32 and 46-60 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Claim Objections (2<sup>nd</sup> time)***

1. Claims 19-32 and 46-60 are objected to because of the following informalities: claims 19-32 and 46-60, claim dependency on claims 3 and 37 which were previously canceled in the application. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 12-36, 39-63 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Barnett et al (U.S. Patent No. 6,321,208).
4. As per claim 12-14, 35-36, 39-41 and 61-63, Barnett et al teach an electronic commerce system (*provided is a system for distributing and generating at a remote site product redemption coupons*) comprising a client computer (*user's remote personal computer, 6*) and a server computer (*online provider, 2*) (*see fig 1*) the client computer and the server computer being interconnected by a public packet switched communications network (*internet*) (*see fig 1*) the

client computer being programmed to transmit to the server computer an order acceptance request (*request for coupon*) comprising a plurality of terms or conditions of a proposed offer for a purchase, the order acceptance request comprising a discrete message that includes at least one of the modular elements (*coupon*) (*fig 5*) individually protected by a cryptographic security code being a digital coupon (*the coupons 18 contain user-specific data in the form of a unique user bar code encoded with user-specific information such as the user name and/or other unique identification criteria such as a social security number or online service address*) (*see fig 1, 2, 5, column 7 lines 20-55*), the server computer being programmed to process the order acceptance request based on pre-programmed criteria including authentication and examination (*verifies the value of the redeemed coupons, determines the identification of users who redeemed the coupons*) of the cryptographic security codes embedded within each of the modular elements and examination of the modular elements of the discrete message individually protected by the cryptographic security codes (*unique user bar code encoded with user-specific information*), and, based on the processing of the order acceptance request, to transmit to the client computer an order acceptance response based on the pre-programmed criteria, the order acceptance response comprising a discrete message transmitted during a negotiation phase of a transaction that includes a plurality of modular elements whose individual integrity is protected by embedding cryptographic security codes within each of the modular elements (*see fig 1, 2, 5, column 7 lines 20-55*), wherein the client computer is programmed to receive the digital coupon, protected by a cryptographic security code, from another computer (*coupon distributor, 16*) (*see fig 1*).

5. As per claim 13, 42, Barnett et al teach a system wherein the client computer is programmed to provide information to the server computer concerning identify of the coupon holder (*see fig 1, 2, 5, column 7 lines 20-55*).

6. As per claim 14-18, 43-45, Barnett et al teach a system wherein the server computer is programmed to authenticate authority of the client computer by virtue of a two-way-authenticated SSL connection using a basic authentication method such as a client certificate (*see fig 1*).

7. As per claim 19, 46, Barnett et al teach a system wherein the digital coupon contains a serial number to ensure that the digital coupon is used only once and the server computer is programmed to determine whether the digital coupon has been used previously and to accept the digital coupon only if it has not been used previously (*see fig 1, 2, 5, column 7 lines 20-55*).

8. As per claim 20, 47, Barnett et al teach a system wherein the server computer is programmed to set at least one term of the order acceptance response based on whether the digital coupon is present in the order acceptance request (*see fig 1, 2, 5, column 7 lines 20-55*).

9. As per claim 21, 48, Barnett et al teach a system wherein the at least one term of the order acceptance response is a price.

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10. As per claim 22-24, 49-51, Barnett et al teach a system wherein the server computer is programmed to set at least one term of the order acceptance response based on whether the digital coupon in the order acceptance request is a particular type of digital coupon (gift certificate comprises a serial number).

11. As per claim 25, 52, Barnett et al teach a system wherein the server computer is programmed to ensure that the serial number has been used only once by checking a database in which the serial number is stored (*see fig 1, 2, 5, column 7 lines 20-55*).

12. As per claim 26, 53, Barnett et al teach a system wherein the client computer is programmed to display an icon of the gift certificate and to initiate the order acceptance request after a recipient of the gift certificate clicks on the icon (*see fig 1, 2, 5, column 7 lines 20-55*).

13. As per claim 27, 54, Barnett et al teach a system wherein further comprising a merchant computer, the merchant computer being programmed to respond to the recipient clicking on the icon by transmitting an order form to the client computer, the client computer being programmed to initiate the order acceptance request when the recipient fills in the order form (*see fig 1*).

14. As per claim 28, 55, Barnett et al teach a system wherein the client computer is a first client computer programmed to receive the gift certificate from a second client computer (*see fig 1*).

15. As per claim 29, 56, Barnett et al teach a system wherein the server computer is programmed to transmit the gift certificate to the second client computer, which in turn is programmed to forward the gift certificate to the first client computer (*see fig 1*).

16. As per claim 30, 57, Barnett et al teach a system wherein the gift certificate comprises a serial number and the server computer is programmed to create the serial number of the gift certificate before transmitting the gift certificate to the second client computer (*see fig 1*).

17. As per claim 31, 58, Barnett et al teach a system wherein the server computer is programmed to store the serial number in a database before transmitting the gift certificate to the second client computer, and is programmed, when it receives the gift certificate from the first client computer to ensure that the serial number has been used only once by checking the database in which the serial number is stored (*see fig 1, 2, 5, column 7 lines 20-55*).

18. As per claim 32, 59, Barnett et al teach a system further comprising a merchant computer programmed to transmit the gift certificate to the server computer before the server computer transmits the gift certificate to the second client computer (*see fig 1*).

19. As per claim 33, 60, Barnett et al teach a system wherein the merchant computer is programmed to transmit the gift certificate to the server computer in the form of an order acceptance request that includes extension information indicating that the order acceptance request is a gift certificate (*see fig 1, 2, 5, column 7 lines 20-55*).

*Response to Arguments*

20. Applicant's arguments filed March 29<sup>th</sup>, 2006 have been fully considered but they are not persuasive.

a. Applicant argues that the prior art fails to teach a system wherein a client computer configured for transmitting an order acceptance request over a network including a plurality of modular elements that are individually encrypted wherein the order of acceptance including modular elements whose integrity is protected by a security code. Examiner respectfully disagrees with Applicant's characterization of the prior art. Barnett et al. teach among other things a shopping list function button calls the shopping list generation routine when selected by the user. This routine will allow the user to generate a list from a menu presented on the screen whichever items the user desires to purchase, and the user can store and/or print this list as desired. The items on the list are compared against coupon data stored in the coupon database and the user is informed of their existence. The user may then print out those coupons along with the shopping list. Alternatively, the user may select certain coupons for printing, and the item associated therewith is automatically placed on the shopping list. Thus, in either fashion, the user's shopping list generation and coupon "clipping" tasks are conveniently merged in a timesaving manner. Examiner disagrees that the bar code provided in the present invention is irrelevant to the cryptographic encoding in the present application. Barnett's coupons contain user-specific data in the form of a unique user bar code. The user bar code is



*encoded with user-specific information such as the user name and/or other unique identification criteria such as a social security number or online service address (emphasis added).* This information renders each printed coupon unique, since an otherwise similar coupon presented by a different consumer will comprise a different user bar code. The use of a unique coupon is but one aspect of the secure nature of the present invention as will be described in detail below. Barnett further indicate that *the unique user bar code renders the electronic coupon system of the present invention secure and virtually fraud-proof.* Although a user is able to print out a particular coupon only once (to be described in detail below), the coupon issuer could still be defrauded by a user or retailer who might photocopy a printed coupon numerous times and fraudulently and repeatedly present it for redemption. However, in accordance with the present invention, each coupon printed by a user is unique, and the scanning of a coupon presented for redemption will be stored at the coupon redemption center. Thus, the coupon issuer will know if a particular user has redeemed a particular coupon and thus disallow further redemption of a photocopied coupon bearing the same indicia.

- b. For the reason state above this action is made final

***Examiner's note***

21. The Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are

representative of the teachings in the art and are applied to the specific limitations within the individual claims, other passages and figures apply as well. It is requested from the Applicant, in preparing the response, to consider fully the entire references as well as the context of all passages in the cited references as potentially teaching all or part of the claimed inventions.

### ***Conclusion***

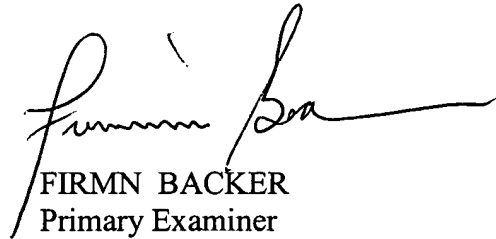
22. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FIRMIN BACKER whose telephone number is 571-272-6703. The examiner can normally be reached on Monday - Thursday 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



FIRMIN BACKER  
Primary Examiner  
Art Unit 3621

June 4, 2006